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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,142	03/03/2004	George H. Forman	10007903-2	4833

7590 09/01/2006

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EXAMINER	
HUFFMAN, JULIAN D	

ART UNIT	PAPER NUMBER
2853	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/792,142	FORMAN, GEORGE H.	
	Examiner	Art Unit	
	Julian D. Huffman	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-13 and 15-24* is/are pending in the application.

4a) Of the above claim(s) *15 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-13,16-18 and 21-24* is/are rejected.

7)☒ Claim(s) *19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 15 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species/invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6 March 2006.

Claims 15 and 20 specify update of an operating system of a host computer, which is solely disclosed with the magnetic embodiment of species 2.

The examiner will rejoin dependent claims 15 and 20 upon the allowance of a generic base claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. (U.S. 5,930,553) in view of Naik et al. (U.S. 5,579,446).

Hirst et al. discloses a print cartridge (18), comprising :

a memory (19) storing readable program code having a downloadable upgrade version of program code for a printer (column 5, lines 1-6 and lines 19-24).

Hirst et al. discloses the memory upgrading color lookup tables (column 5, lines 19-24). Hirst et al. also discloses in an alternative embodiment, storing the printer driver in a host computer (column 5, lines 1-6).

Hirst et al. does not expressly disclose a printer driver with color look-up tables stored in a host computer.

Naik et al. discloses a host computer (44) storing a printer driver (32, column 5, lines 35-38) with color look-up tables (column 7, lines 28-31).

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the printer driver of Naik et al. into the host computer of Hirst et al. for the purpose of providing a printer driver that enables automatic or customized settings respecting color correction as well as halftoning (column 3, lines 1-4).

Since Hirst et al. discloses updating color look up tables and the combination stores the color look up tables in a printer driver of a host computer, the combination teaches upgrading the color look up tables/program code in the host computer.

4. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst in view of Naik as applied to claim 11 above and further in view of Apple Computer, Inc.

Hirst as modified by Naik discloses everything claimed with the exception of program code for automatically determining whether the upgrade version of program code is required for the computer and if the upgrade version is required, then downloading the upgrade version from the memory to the computer.

However, Apple Computer, Inc. discloses a memory device storing program code to upgrade software in a computer including program code which executes the steps of automatically determining whether the upgrade version of program code is required for the computer and if the upgrade version is required, then downloading the upgrade version from the memory to the computer.

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate into the software of Hirst programming code executing the steps executed by the code of Apple Computer, Inc. for the purpose of preventing unnecessary upgrading which can reduce the lifetime of the device.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst in view of Naik as applied to claim 11 above and further in view of Bealkowski et al.

Hirst as modified by Naik discloses everything claimed with the exception of program code for notifying a user when a partial upgrade occurs.

Bealkowski et al. discloses program code for notifying a user if an error occurs, which is equivalent to a partial upgrade (column 14, lines 32-35 and 39-41, fig. 8, if a full upgrade had occurred, there would be no errors detected).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the upgrade program of Hirst et al. to notify the user when a partial upgrade or error has occurred as suggested by Bealkowski et al. for the purpose of enabling the user to try again or call for service (column 14, lines 39-41).

6. Claims 16-18, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst in view of Naik et al. and Apple Computer, Inc.

Hirst discloses a method of software execution comprising:

recognizing downloadable code stored in a print cartridge and downloading the upgrade code from the print cartridge, sensing when the print cartridge is positioned in a printer before downloading the code from the print cartridge (column 5, lines 19-24 and 54-65).

Hirst et al. discloses the memory upgrading color lookup tables (column 5, lines 19-24). Hirst et al. also discloses in an alternative embodiment, storing the printer driver in a host computer (column 5, lines 1-6).

Hirst et al. does not expressly disclose a printer driver with color look-up tables stored in a host computer.

Hirst et al. does not disclose program code which executes the steps of automatically determining whether the upgrade version of program code is required for the host computer and if the upgrade version is required, then downloading the upgrade version from the memory to the host computer and if the upgrade is not required, ignoring the code on the print cartridge, and determining if the code is compatible with the host computer and if the code is not compatible aborting any downloading of the code from the print cartridge to the host computer.

Naik et al. discloses a host computer (44) storing a printer driver (32, column 5, lines 35-38) with color look-up tables (column 7, lines 28-31).

Since Hirst et al. discloses updating color look up tables and the combination stores the color look up tables in a printer driver of a host computer, the combination teaches upgrading the color look up tables in the host computer.

Apple Computer, Inc. discloses a memory device storing program code to upgrade software in a computer including program code which executes the steps of automatically determining whether the upgrade version of program code is required for the computer and if the upgrade version is required, then downloading the upgrade version from the memory to the computer and if the upgrade is not required, ignoring the code on the print cartridge, and determining if the code is compatible with the computer and if the code is not compatible aborting any downloading of the code from the print cartridge to the computer (the device checks the version of the firmware code and will only update the firmware of the appropriate devices, a device not compatible with the code or a device which has already been updated is not updated and the upgrade code is ignored).

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the printer driver of Naik et al. into Hirst et al. for the purpose of providing a printer driver that enables automatic or customized settings respecting color correction as well as halftoning (column 3, lines 1-4).

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate into the software of Hirst programming code executing the steps executed by the code of Apple Computer, Inc. for the purpose of preventing overwriting of program code with incompatible upgrade code which can cause device

failure and preventing unnecessary upgrading which can reduce the lifetime of the device.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst in view of Naik and Apple Computer, Inc. as applied to claims 16-18, 21, 23 and 24 above, and further in view of Bealkowski et al.

Hirst as modified discloses everything claimed with the exception of program code for notifying a user when a partial upgrade occurs.

Bealkowski et al. discloses program code for notifying a user if an error occurs, which is equivalent to a partial upgrade (column 14, lines 32-35 and 39-41, fig. 8, if a full upgrade had occurred, there would be no errors detected).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the upgrade program of Hirst et al. to notify the user when a partial upgrade or error has occurred as suggested by Bealkowski et al. for the purpose of enabling the user to call for service (column 14, lines 39-41).

Allowable Subject Matter

8. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 13 June 2006 have been fully considered but they are not persuasive.

Regarding claim 11, applicant argues that the printer is not a host computer. This is not found persuasive. A cartridge communicates with a microprocessor in a printer. The microprocessor in the printer is a host computer for the cartridge. Applicant sites a dictionary definition for support. Dictionaries are problematic as sources of claim construction. "...the patent applicant did not create the dictionary to describe the invention. Thus, there may be a disconnect between the patentee's responsibility to describe and claim his invention, and the dictionary editors' objective of aggregating all possible definitions for particular words... A claim should not rise or fall based upon the preferences of a particular dictionary editor" (Phillips v. AWH Corporation et al. 75 USPQ2d 1321 (CAFC 2005)). Examining the dictionary definitions provided, it becomes immediately clear that the definitions are inconsistent even with applicant's use of the term "host computer". The first definition describes two computers connected together by modems or telephone lines. The second definition describes two computers connected by the internet with IP addresses. Applicant teaches none of the above in the specification. Thus applicant's own specification is inconsistent with the dictionary definition and this merely illustrates the problems associated with dictionary definitions. Further, since applicant has not explicitly defined the term host computer, and the examiner must interpret the claims broadly, it is entirely appropriate to state that the printer acts as a host computer for the cartridge.

Applicant further argues that Hirst does not disclose a host computer in communication with a printer that includes the print cartridge.

The examiner challenges applicant to point out how the "program code for a host computer" is structurally different than program code for a printer. The program code is equally capable of upgrading a host computer, or a printer, just as HTML programming code on a website is capable of communicating to virtually any type of computer running any known operating system.

Further, Hirst in view of Naik et al. disclose the claimed invention, as discussed above.

Applicant's arguments regarding lack of motivation to combine references and hindsight reconstruction are not well taken.

"A critical task of the examiner in formulating an obviousness type rejection is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field", *See Dembiczak* , 175 F.3d at 999, 50 USPQ 2d at 1617.

Motivation to combine the references is clearly provided by the examiner, and this motivation is suggested in the applied references. Additionally, the references are all concerned with the same problem, updating software in a computer. In any two references, one can always find or point to a difference amongst the two references. Here applicant focuses on the specific distinguishing details in each reference and ignores the basic overall teachings; that each reference is concerned with upgrading software in a computer.

Conclusion

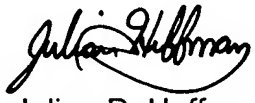
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 10:00a.m.-6:30p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Julian D. Huffman
Art Unit 2853
22 August 2006